

REMARKS

Claims 1-31 are pending in the application. By this Reply, the Abstract has been replacement with a new Abstract attached hereto on a separate sheet. No new matter has been added.

In the Office Action dated October 10, 2005, the Examiner objected to the Abstract as allegedly containing improper language. Applicant has amended the Abstract to remove the allegedly improper language and attached the replacement Abstract hereto on a separate sheet. Accordingly, Applicant respectfully requests withdrawal of the objection to the Abstract.

At paragraph 3 of the Office Action, the Examiner rejected claims 1-31 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,933,497 to Beetcher et al. (hereinafter “Beetcher”) in view of U.S. Patent No. 6,526,512 to Siefert et al. (hereinafter “Siefert”). Applicant respectfully traverses this rejection.

Initially, Applicant notes that in paragraph 2.2 of the Office Action (page 3, lines 10-11), the Examiner alleges that “[t]he cited art Beetcher either alone or in combination with Siefert teaches or suggests the claims as amended.” However, the Office Action does not contain any claim rejection based on Beetcher alone. Indeed, the Office Action includes only one claim rejection, which relies upon a combination of Beetcher and Siefert. Therefore, Applicant rejects the Examiner’s allegation that Beetcher alone teaches or suggests the claims.

Regarding the rejection under § 103(a), the Examiner apparently relies upon Siefert for teachings of claimed features that are not disclosed by Beetcher. However, the Examiner does not identify the claimed features that are not disclosed by Beetcher. Nonetheless, the Examiner refers to an alleged teaching in Siefert of a first authorization level being assigned to an electronic device and authorizing the device to run controlled applications having authorization levels not exceeding the first authorization level. Consequently, Applicant deems the Examiner’s reference to this alleged teaching of Siefert as an acknowledgment that Beetcher fails to disclose at least this feature of the claims.

This acknowledgment by the Examiner is consistent with Applicant’s remarks in the Amendment filed on April 28, 2005. Specifically, in Beetcher, each encrypted entitlement key is designed to enable operation of particular software that is distributed. Thus, there exists within Beetcher an assignment between an encrypted entitlement key and a particular distributed

software. In the present claims, independent claim 1 for example, the authorization level is assigned to an electronic device and authorizes the electronic device to run controlled applications having authorization levels not exceeding the first authorization level. There is no correspondence to a particular application. This lack of correspondence enables the authorization level to apply to all controlled applications on the electronic device, not just to a particular controlled application, as in Beetcher. Further, even Beetcher's version field applies only to versions of a distributed software application and, thus, cannot be applied to the computer as a whole. For at least these reasons, Beetcher fails to disclose or suggest the features of independent claim 1. For similar reasons, Beetcher also fails to disclose or suggest the features of independent claims 13 and 20.

Regarding the rejection under § 103(a), the Examiner has not demonstrated the requisite motivation to combine the teachings of Beetcher with Siefert. To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." M.P.E.P. § 2142.

Several other principles concerning an obviousness rejection are applicable here. These requirements were mentioned briefly in the previous office action. If the Examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. § 103, the Examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the appellant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The legal standard of "a

preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. M.P.E.P. § 2142.

Furthermore, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the Examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 U.S.P.Q.2d 1089 (Fed. Cir. 1991). M.P.E.P. § 2143.01. Thus, the M.P.E.P. requires that each prior art reference must be considered in its entirety, as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). M.P.E.P. § 2143.01.

Applying these principles, Appellant traverses the conclusion that one of skill in the art would be motivated to combine Siefert with Beetcher. In this case, Beetcher relates to a system and method of controlling access to software where entitlement keys include a serial number of a computer on which a particular software application is entitled to run. See Abstract. The focus and scope of the subject matter is primarily on controlling access to a single software application (potentially with multiple versions).

In contrast, Siefert teaches a system and method that provides access key codes for resources (e.g., programs and data) and users. See Abstract. Siefert does not disclose or suggest key codes being associated with an electronic device. The Examiner asserts in the final Office Action that it would have been obvious to combine Siefert's alleged teachings of a first authorization level being assigned to an electronic device and authorizing the device to run controlled applications having authorization levels not exceeding the first authorization level with the device of Beetcher because it would provide "the advantage of preventing hacker [sic]

from learning the identities of the key codes and preventing hacker [sic] from learning how the security process run [sic] by assigning key codes (authorization levels) to both the computer and the program.” Appellant respectfully disagrees and submits that there is insufficient motivation or suggestion to combine these references.

First, as discussed above, Siefert does not disclose or suggest assigning key codes to a computer. Therefore, the Examiner’s alleged motivation is inaccurate and unsupported by Siefert. Furthermore, since Beetcher does not disclose key codes (authorization levels), it is not clear what alleged key code identities in Beetcher a hacker would be prevented from learning. Since Siefert does not disclose or suggest assigning key codes to a device and Beetcher, a person skilled in the art would not have looked to Siefert to solve a problem where key codes (authorization levels) are assigned to a device. And since Beetcher does not disclose key codes (authorization levels), there would be no reason to modify Beetcher with the alleged teachings of Siefert to prevent someone from learning identities of such non-existent key codes. Therefore, Applicant submits that the Examiner has not presented evidence of sufficient motivation to combine the alleged teachings of Siefert with Beetcher. Accordingly, for at least these reasons, the § 103(a) rejections should be withdrawn.

Assuming, *arguendo*, that the alleged teachings of Siefert can be combined with the device of Beetcher (which Applicant rejects), Siefert still fails to overcome the above-noted deficiencies of Beetcher. Siefert discloses a security system for computer repositories that contain resources such as programs and data. Siefert discloses key codes that are assigned to resources and users. Col. 2, lines 40-65 and col. 4, line 44 through col. 5, line 55. Siefert does not disclose or suggest assigning key codes to an electronic device. Even if Siefert’s key codes can be compared with the claimed authorization levels (which Applicant does not admit), Siefert does not disclose or suggest assigning an authorization level to an electronic device that authorizes the electronic device to run controlled applications having authorization levels not exceeding the first authorization level. Therefore, the alleged teachings of Siefert in combination with Beetcher do not disclose or suggest the features of independent claim 1. For similar reasons, the combination of Siefert with Beetcher also fails to disclose or suggest the features of independent claims 13 and 20. Accordingly, the § 103(a) rejection of independent claims 1, 13, and 20 should be withdrawn.

Claims 2-12, 14-19, and 21-31 depend from either claim 1, claim 13, or claim 20 and are therefore allowable for at least the same reasons that respective claim 1, 13, or 20 is allowable, as well as for their own unique features. Accordingly, Applicants respectfully request withdrawal of the § 103(a) rejections of claims 2-12, 14-19, and 21-31 and timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned attorney at 410-414-3056.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Request for Reconsideration, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§1.16 or 1.17, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge the fee to our Deposit Account No. 50-3102.

Respectfully submitted,

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